

Appl. No. : 10/682,460

Filed : October 8, 2003

REMARKS

The Office Action mailed on October 22, 2007, has been carefully considered. Accordingly, the changes presented herewith, taken with following remarks, are believed sufficient to place the present application in condition for allowance. Reconsideration is respectfully requested.

Claims 1-44 are currently pending, with claims 6, 8, 12, 13, 19, 21, 25-28, 34, 36, and 40 being withdrawn from consideration. Claims 1-4 and 14-17 are rejected under U.S.C. 103(a) as being unpatentable over USPN 7,083,591 ("Urich") in view of US Patent Application Number 2004/0229814 ("Dillon"). Claims 5, 7, 9-11, 18, 20, and 22-24 stand rejected under U.S.C. 103(a) as being unpatentable over Urich in view of Dillon, and further in view of USPN 5,084,009 ("Mackool"). Claims 29-32 stand rejected under U.S.C. 103(a) as being unpatentable over Urich in view of Dillon, and further in view of USPN 5,554,894 ("Sepielli"). Claims 33,35, and 37-39 stand rejected under U.S.C. 103(a) as being unpatentable over Urich in view of Dillon, and further in view of Sepielli and Mackool. Claims 41 and 42 stand rejected under U.S.C. 103(a) as being unpatentable over Urich in view of Mackool. Applicants traverse these rejections for the reason discussed in greater detail below.

Claims 1, 14, 29, 41, and 43 have been amended to change certain typographical errors. Applicants assert that the scope of these claims has not changed as a result of these amendments and that no new matter has been thereby introduced.

Prior to the present Office Action, claims 6, 8, 12, 13, 19, 21, 34, 36, and 40 were withdrawn from further consideration as being drawn to a non-elected species. Because claims 1, 14, and 29 are believed allowable as amended, Applicants respectfully request that claims 6, 8, 12, 13, 19, 21, 34, 36, and 40 be reinstated as depending from an allowable base claim. In addition, claims 25-28 were previously withdrawn from further consideration as being drawn to a non-elected species. In order to put the present case in better condition for allowance, claims 25-28 have cancelled without prejudice. Applicants reserve the right to prosecute claims 25-28 at a later time.

Claims 1-4, 14-17 Are Patentable Over Urich and Dillon.

Urich teaches a surge suppresser which has a collapsible flexible wall that accumulates the aspiration fluid of an interocular surgical system. The surge suppresser has an inlet port and an outlet port that are connected to an aspiration line downstream from a surgical tip. When an occlusion in the aspiration line occurs, the flexible wall collapses and closes the inlet and outlet ports of the surge suppresser. When the occlusion breaks, the closed outlet port prevents a surge of fluid from the eye. Urich column 1, lines 45-58.

By contrast claim 1 is directed to an infusion source comprising, in pertinent part, an irrigation line interconnecting the fluid supply and an irrigation lumen and a tubular member disposed along the irrigation line and having an expandable wall configured to expand during occlusion of an aspiration lumen and to enhance flow of fluid into the irrigation lumen upon clearing of the occlusion.

Urich does not teach or even suggest a tubular member configured to enhance flow of fluid into an irrigation lumen upon clearing of the occlusion. To the contrary, Urich specifically teaches a surge suppresser configured to prevent surge of fluid from an eye when an occlusion break. Thus, Urich actually teaches away from enhanced flow upon clearing of an occlusion, as recited in claim 1.

For example, in column 3, lines 10-12, Urich states, in reference to when an occlusion becomes dislodged, "The expansion of the flexible wall 26 and the accumulation of aspiration fluid prevents a sharp surge in the flow of fluid from the eye." (Emphasis added). By contrast, claim 1 recites a tubular member configured to enhance flow. According to an embodiment of the Applicants' invention, the enhanced flow into the irrigation lumen insures regulation of pressure within the eye during surgery when increased suction causes fluid within the surgical site to rush suddenly into the aspiration lumen (e.g., following the clearing of the occlusion). Thus, the infusion source, as recited in claim 1, provides for fluid flow upon clearing of an occlusion, while Urich teaches a surge suppresser that impedes fluid flow upon clearing of an occlusion.

Furthermore, Urich does not teach or suggest an expandable wall configured to expand during occlusion of an aspiration lumen. To the contrary, in reference to FIG. 3, Urich teaches that when an occlusion 34 occurs, the vacuum pump 22 will decrease the pressure downstream from the occlusion and the decrease in pressure will cause the flexible wall 26 to collapse. Urich, column 2, line 65 to column 3, line 4. Again, Urich not only fails to teach or suggest the claimed infusion source, but actually teaches away from the limitations of claim 1.

The Examiner contends that it would have been obvious to one of ordinary skill in the art to modify the device of Urich such that a flow-limiting member is disposed along the irrigation line as part of, and in fluid communication with, an irrigation line. However, Applicants respectfully assert that the Examiner has not provided a compelling reason why such a modification of the Urich system would have been obvious. The guidelines recently published by the USPTO for examination of patent applications in determining obviousness, in view of the Supreme Court decision in KSR v. Teleflex, indicate that the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the

Appl. No. : 10/682,460

Filed : October 8, 2003

reason(s) why the claimed invention would have been obvious (Federal Register, October 10, 2007, Vol. 72, No. 195, page 57528, last paragraph).

The reason put for by the Examiner for disposing the flow-limiting member of Urich in the irrigation line is to prevent excessive flow of irrigation solution to the surgery site. However, neither Urich nor Dillon teach or suggest such a variant. To the contrary, in reference to FIG. 3, Urich teaches that when an occlusion occurs, the vacuum pump 22 will decrease the pressure downstream from the occlusion and the gravity bottle 18 will increase the fluid pressure upstream from the occlusion. The decrease in pressure will cause the flexible wall 26 to collapse and close the ports 30, 32 of the surge suppresser. Urich, column 2, line 65 to column 3, line 4. Applicants assert that the surge suppresser of Urich would not function in this manner if disposed within an irrigation line. To the contrary, an occlusion generally increases pressure in an irrigation line (or at least maintains constant pressure), so that the flexible wall 26 of Urich would NOT collapse and close the ports 30, 32 during an occlusion, if disposed in the irrigation line. Without the closure of ports 30, 32, Applicants fail to see how the surge suppresser of Urich could function to “prevent excessive flow of irrigation solution,” as asserted by the Examiner. Thus, the Examiner has failed to clearly articulate a reason why the claim 1 would have been obvious in light of Urich or Dillon, as required under the recent guidelines for determining obviousness.

Independent claim 14 has limitations similar to those found in claim 1, and is patentable over Urich and Dillon at least for reasons similar to those discussed above in relation to claim 1. At least because Urich or Dillon, either alone or in combination, do not teach or suggest all of the limitations of claims 1 and 14, Applicants request the Examiner allow claims 1 and 14. Claims 2-4 and 15-17 depend from claims 1 or 14 and further define the invention of claims 1 and 14. Thus, claims 2-4 and 15-17 are patentable over Urich and Dillon at least for the same reasons that claims 1 and 14 are patentable thereover, and are patentable in their own right as well.

Claims 5, 7, 9-11, 18, 20, 22-24, 29-33, 35, 37-39, and 41-44 Are Patentable Over the Prior Art.

Claims 5, 7, 9-11, 18, 20, 22-24, 29-33, 35, 37-39, and 41-44 stand rejected under U.S.C. 103(a) as being unpatentable over Urich in various combinations with Dillon, Mackool, and/or Sepielli. Claims 5, 7, 9-11, 18, 20, 22-24, 29-33, 35, 37-39, and 41-44 include limitations similar to those discussed above in relationship to claim 1. Since Dillon, Mackool, or Sepielli do not make up for the deficiencies of Urich, Applicants assert that claims 5, 7, 9-11, 18, 20, 22-24, 29-33, 35, 37-39, and 41-44 are patentable over

Appl. No. : 10/682,460

Filed : October 8, 2003

Urich, Dillon, Mackool, and Sepielli at least for the same reasons that claim 1 is patentable thereover, and are patentable in their own right as well. At least because Urich, Dillon, Mackool, or Sepielli, either alone or in combination, do not teach or suggest all of the limitations of claims 5, 7, 9-11, 18, 20, 22-24, 29-33, 35, 37-39, and 41-44, Applicants request the Examiner allow claims 5, 7, 9-11, 18, 20, 22-24, 29-33, 35, 37-39, and 41-44.

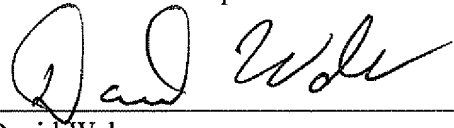
CONCLUSION

Based on the foregoing, Applicants respectfully assert that the claims now pending are allowable over the prior art. Therefore, Applicants earnestly seek a notice of allowance and prompt issuance of this application.

The Commissioner is hereby authorized to charge payment of any fees associated with this communication to Deposit Account No. 502317.

Respectfully submitted,
Advanced Medical Optics

Dated: January 22, 2008

By: 

David Weber
Registration No. 51,149
Agent of Record
Customer No. 33357
(714) 247-8232